



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,505	11/13/2001	Urs Loher	215871US6PCT	6835

22850 7590 06/23/2005

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,505

Applicant(s)

LOHER ET AL.

Examiner

Arrienne M. Lezak

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Examiner notes that Claims 22-45 have been added, Claims 1-21 have been amended and no claims have been cancelled. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 13 January 2005 as reiterated herein below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, Examiner notes that Claim 1 was amended to include the language, "without transmitting the data of the spoken language through the chat server", which language is a negative non-enabling limitation requiring removal of the same. For purposes of examination, said portion of the claim language will not be considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of the teachings of US Patent Pub. US 2001/0009014 A1 to Savage in view of US Patent Pub. US 2002/0174248 A1 to Morriss in further view of US Patent US 6,173,250 B1 to Jong.

5. Regarding Claims 1, 12, 29 & 34, Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network, which method includes a chat server comprising a communications module for connection with telecommunications networks, (paragraphs #0003 & #0130) in which communication participants communicate with one another by means of communications terminals, (paragraphs #0011-0023 & Claims 1-55);

which server has a table in which information about communication forums is stored, (per pending Claim 12), (paragraph #0078 – “log file”), (Examiner further notes that Savage teaches dynamic creation and allocation of conferences among the media servers as facilitated by a single dispatch server wherein it would have been obvious to incorporate a table into said dispatch server for purposes of said dynamic allocation as said conference database tables are well known in the art, (see Krishnaswamy et al. below), (Examiner further notes that Morriss teaches a buddy list – paragraph #0025 – a

subscriber database – paragraph #0040 – and a wireless network/chat database – paragraph #0049 – wherein information such as discussion topics, target participant groups, number of participants, temporal and geographical validity, expiration and language would have been obvious to store therein);

and which server has a command module that is set up such that it is able to receive and execute commands from the said communication participants, (paragraphs #0011-0023),

the said command module enabling the said communication participants to select one of the said communication forums by means of the said commands, (paragraphs # 0012 & #0023);

the said communications module being set up such that it is able to interconnect at least two of the said communication participants who have selected a common communication forum for a round of communication, in which the said communication participants communicate by means of spoken language, (conferences), over a said telecommunications network, (Abstract; paragraphs #0007 & #0011-0013) wherein

- the command module is moreover set up such that it is able to receive over the said telecommunications networks said commands entered by the said communication participants by means of the said communication terminals, (paragraphs # 0011-0023).

6. Though Savage teaches a command module capable of management services, Savage does not specifically enumerate a chat server facilitating selection and interconnection. Morriss teaches a chat room server management functionality,

(paragraphs #0005 & 0025). It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the Morriss chat room server into the Savage conferencing system in order to efficiently utilize wireless bandwidth to provide chat messaging, (Morriss – paragraph # 0011). Examiner notes that Savage teaches a dispatch server and a media server for facilitating communication connections, (Savage – paragraphs #0016-0020), and Morris teaches a chat server which manages chat messaging among wireless devices, (Morriss – paragraph #0025), wherein it would have been obvious to utilize the Morris chat server to perform those functionalities already performed by one or more servers within the Savage system. Additionally, Savage teaches the ability to couple to a telecommunications network, (paragraph # 0130), such as the wireless network described within Morriss.

7. Though Savage teaches a telecommunication network capable of utilizing telephone technology which telephones obviously facilitate communication via spoken language, Examiner additionally cites Jong for Jong discloses a chat site wherein communication is initiated via a speech-controlled device, (Col. 5, lines 4-11). Examiner notes that it would have been obvious to use the Jong speech-to-text transmit system for purposes other than communication initiation, as said system serves to recognize spoken words and convert the same to text. Thus, the Jong speech-to-text functionality could easily be used in conjunction with a menu means for purposes of facilitating conferences within the system. It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to combine the teachings of Savage and Jong to provide reliable, high quality communications over the dedicated connections of the

public telephone infrastructure, (Savage – paragraph #0003). As a wireless phone network is a public phone network, it would have been obvious to incorporate the same into the telecommunication teachings of Savage. Additionally, Examiner notes that Morriss clearly teaches wireless communication, including, but not limited to cellular telephones, (per pending Claim 34 – spoken language communication terminal), (Morriss – paragraph #0026). Thus, Claims 1, 12, 29 & 34 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

8. Regarding Claims 2, 13 & 43, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Jong discloses a telecommunications network wherein the subscriber terminals may be wireless telephones, (obviously on a wireless network, (Jong – Col. 2, lines 65-67 & Col. 3, lines 1-4), which subscriber terminals may participate in chat communication, (Jong – Col. 4, lines 57-58). Additionally, Morriss clearly teaches wireless/cellular telephone use, (Morriss – paragraph # 0026), wherein use of a digital mobile phone network or ISDN would have been obvious, (per pending Claim 43). Thus, Claims 2, 13 & 43 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

9. Regarding Claims 3, 14, 23, 33, 40 & 41, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network, wherein the communication participants select, via a menu structure, a communication forum from a list of defined communication forums or define a new communication forum, a defined

Art Unit: 2143

communication forum being assigned a designation, designating for example a topic, (paragraphs #0011-0023, #0120 & Fig. 13). Examiner notes that the use of a menu (design) structure for conference/forum selection purposes by designation would have been obvious to incorporate within a conference-enabled web page and would obviously include any designation. Additionally, Examiner notes that Morriss teaches SMS, (per pending Claim 41), (Morriss – paragraph #0024) and chat menus, (Morriss - paragraphs #0044-0046), which menus are obviously created via applets, (per pending Claims 33 & 40), (Savage – paragraph #0012). Thus, Claims 3, 14, 23, 33, 40 & 41 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

10. Regarding Claims 4, 15 & 24, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network, wherein the menu structure is displayed on a display of the said communications terminals, and the communication forum is selected or defined by means of operating elements of the communications terminals, (paragraphs #0011-0023, #0120 & Fig. 13). Examiner notes that the use of a menu (design) structure for conference/forum selection purposes by designation would have been obvious to incorporate within a conference-enabled web page. Thus, Claims 4, 15 & 24 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

11. Regarding Claim 5, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Jong discloses a chat site wherein communication is

initiated via a speech-controlled device, (Col. 5, lines 4-11). Examiner notes that it would have been obvious to use the Jong speech-to-text transmit system for purposes other than communication initiation, as said system serves to recognize spoken words and convert the same to text. Thus, the Jong speech-to-text functionality could easily be used in conjunction with a menu means for purposes of facilitating conferences within the system. Thus, Claim 5 is found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

12. Regarding Claims 6, 16, 31, 32 & 37-39, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network, (paragraphs #0011-0023). Savage does not specifically enumerate communication forum participation limitations based upon assigned geographic area. Examiner notes that limitation by geographic distinction would have been obvious as such limitations are well known in the "chat room" art for purposes of chat room designation, participation and limitation. As Savage discloses a conference (chat) system, it would have been obvious to incorporate geographic limitations into the same. Additionally, Examiner notes that Morriss teaches submission of client information to the chat server, (Morriss – paragraphs #0045-0049), (per pending Claim 31), which information would obviously include geographic location data determined by terrestrial-based or satellite-based receivers, (per pending Claims 32, 38 & 39), (Morriss – Fig. 2), as geographical client data transmission is necessary for bi-directional communications, as taught by Morriss. Moreover, geographic limitations are obvious and well-known, especially in wireless

Art Unit: 2143

networks, as when one travels beyond the capability for receipt of network transmission, communication is obviously ended. Thus, Claims 6, 16, 31, 32 & 37-39 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

13. Regarding Claims 7 & 17, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network wherein access to a said communication forum can be denied to an interested communication participant, (paragraphs #0011-0023). Examiner notes that an interested participant may be denied in a number of ways, including non-validation, non-existence, or over capacity, all of which would have been obvious in light of the teachings of Savage. Thus, Claims 7 & 17 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

14. Regarding Claims 8 & 18, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network wherein the said communications terminals are interconnected for a said communication round by means of conference circuit, (Abstract & paragraph #0011). Thus, Claims 8 & 18 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

15. Regarding Claims 9, 19, 28, 44 & 45, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for

Art Unit: 2143

facilitating conferences between a plurality of participants on a network wherein one of the said communication participants registers for a communication forum when no other communication participant has yet selected the respective communication forum, and a round of communication between the registered communication participant and at least one other communication participant begins when this at least one other communication participant has selected the respective communication forum, (Abstract & paragraphs #0011-0023), wherein a new communication forum is defined and a topic is assigned thereto, (per pending Claim 28). Additionally, Morriss teaches selection of a chat room from a menu/list, (Morriss – paragraph #0044-0046), wherein said list obviously includes chat room information such as topic data for both previously existing as well as new chat rooms. Moreover, in transmitting said menu to the client, Morriss obviously teaches sending information on the common forum to at least one participant before interconnecting, (per pending Claim 44), wherein said information could be any information included in the aforementioned subscriber or network database, which information obviously includes geographic distances, language and number of participants, (per pending Claim 45). Thus, Claims 9, 19, 28, 44 & 45 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

16. Regarding Claims 10 & 20, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage is relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network. Savage does not specifically enumerate wherein

Art Unit: 2143

one of the said communication participants registers for at least one communication forum specifying in addition at least one other communication participant as a communication partner for the respective communication forum, so that he is notified when a specified communication partner has selected a respective communication forum. Jong discloses a "chat" communication forum that includes lists of current chat participants wherein members may designate specific communication partners, (Jong – Col. 5, lines 57-67 & Col. 5, lines 1-34). Examiner notes that in designating a specific communication partner, said designee will obviously notify other participants of his/her interest to participate in the communication forum by his/her joining of the same, as noted by said list. Thus, Claims 10 & 20 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

17. Regarding Claims 11 & 21, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses a method and apparatus for facilitating conferences between a plurality of participants on a network. Savage does not specifically enumerate wherein at least certain of the said communication forums have a temporally limited availability, however, the same would have been obvious in light Savage which teaches time stamping client conference participation. Examiner notes that Savage provides for a time-notification functionality in addition to a conference creation and deletion functionality wherein a temporally limited conference would be an obvious means by which to limit conference participation so as to not exceed server capacity, as a preventative means. Thus, Claims 11 & 21 are found to be unpatentable

over considerable consideration of the combined teachings of Savage, Jong and Morriss.

18. Regarding Claims 22, 27 & 42, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Morriss discloses wherein the communication network includes at least one of a GSM or a UMTS network, (Morriss – paragraph #0024). Thus, Claims 22, 27 & 42 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

19. Regarding Claims 25, 26, 30, 35 & 36, Savage, Jong and Morriss are relied upon for those teachings disclosed herein. Savage discloses authorizing the at least on communication participant to the communication forum by requesting a personal access code entered by using said at least one communication terminal, (per pending Claims 25 & 35), (Savage – Fig. 1 & paragraphs #0047-0051), wherein said access code is obviously stored at a communication terminal as subscriber ID data, (per pending Claim 26), (Savage – Fig. 1 & paragraphs #0047-0051), and wherein said personal access code is checked in accordance with information of the table, (per pending Claim 30), (i.e.: Morriss – subscriber database – Fig. 1), (Savage – Fig. 1 & paragraphs #0047-0051). Verification via a SIM card would have been obvious and was also well-known in the art at the time of invention by Applicant, (see Shteyn below). Thus, Claims 25, 26, 30, 35 & 36 are found to be unpatentable over considerable consideration of the combined teachings of Savage, Jong and Morriss.

Response to Arguments

20. Applicant's arguments filed 12 April 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

21. Regarding Applicant's argument that the prior art does not teach "transmitting the data of the spoken language through the chat server", the same has been rejected under 35 U.S.C. 112, as noted herein above. Additionally, the combined teachings of Savage, Morriss and Jong clearly disclose interconnecting of terminals, (Savage – paragraph #0040), for communication and transmission of spoken data through a network, (Morriss – paragraph #0026). Regarding Applicant's argument that media servers are not communication terminals, Examiner notes that the communication terminals are clearly meant to be the client devices, and as such read upon Applicant's claims. Regarding Applicant's argument that Savage teaches distribution of management tasks over different servers, Examiner disagrees noting the dispatch server functionalities (as taught by Savage) and the chat server functionalities (as taught by Morriss). Finally, regarding Applicant's argument that Savage does not teach uploading of a mune structure to the terminals, Examiner disagrees noting the Savage web page is sent to the client for identification purposes, wherein a client join request causes the server to send a list of information regarding other participants, (Savage –

paragraphs #0047-0053). Additionally, Examiner notes that Morriss also teaches a menu structure as noted herein above.

22. Examiner has addressed Applicant's Amendment, and has further rejected all Amended, Original and Newly Added Claims, as noted herein above. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 5,999,525 to Krishnaswamy;

US Patent Pub. US 2003/0063072 A1 to Brandenburg;

US Patent Pub. US 2002/0184391 A1 to Phillips;

Art Unit: 2143

US Patent Pub. US 2002/0144007 A1 to Shteyn.

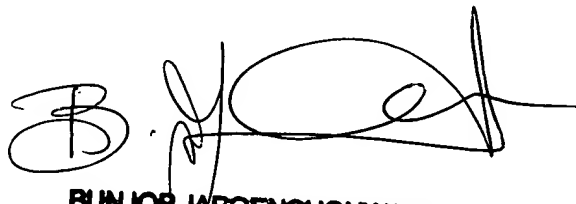
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
Art Unit 2143

AML



BUNJOB JAROENCHONWANT
PRIMARY EXAMINER